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10/051,340	01/18/2002	Lou Chauvin	83304EF-P	9965

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EXAMINER

CHANKONG, DOHM

ART UNIT	PAPER NUMBER
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2152

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/051,340

Applicant(s)

CHAUVIN ET AL.

Examiner

DOHM CHANKONG

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 23-29, 31, 32 and 34-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 23-29, 31, 32, and 34-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

1> This action is in response to Applicant's request for continued examination. Claims 23-25, 28, 29, 31, 34-38, 39, 42, and 43 are amended. Claims 30 and 33 are canceled. Claims 23-29, 31, 32, and 34-43 are presented for further examination.

2> This is a non-final rejection.

Continued Examination Under 37 CFR 1.114

3> A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2.26.2008 has been entered.

Response to Arguments

4> Applicant's arguments have been considered but are moot in view of the new ground of rejection set forth in this action and necessitated by Applicant's amendment.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because

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the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5> Claims 23-44 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No. 10/050,979. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the claims of the present application and the claims of the copending application are directed towards providing an offering based on a business relationship between a business entity and service provider. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6> Claims 23-27, 29, 31, 32, 34-37, and 39-44 are rejected under 35 U.S.C §103(a) as being unpatentable over Reifel et al, U.S Patent No. 7,013,288 [“Reifel”] in view of Mizumo, U.S. Patent Publication No. 2001|0021311.

7> As to claims 23, 34 and 44, Reifel discloses a method comprising:

providing a network service on a network [Figure 1];

allowing a user to access a network server via the network service for ordering products using a network connected order terminal, said order terminal associated with one of a plurality of business entities [Figure 1 | Figure 3 «item 308» | Figure 13 «items 20, 25»];

in response to a user coupling a portable digital storage device to a network connected order terminal [column 3 «lines 35-39»], electronically reading the portable digital device, the portable digital storage device associated with one of a plurality of storage device providers and having an image stored thereon [column 3 «line 53» to column 4 «line 4» : manufacturers providing a camera to the user], said one of the plurality of the plurality of storage device providers identified by electronically reading a code stored on the portable digital storage device [column 12 «lines 29-38» | column 13 «lines 10-14» : camera-related information stored on the camera], the plurality of storage device providers each having a predefined business relationship with each of said plurality of business entities [column 5 «lines 28-44» | column 12 «line 6»];

maintaining relationship data indicating a rating of the predefined business relationships in a database coupled to the communication network [column 5 «lines 28-44» |

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column 12 «line 6» : camera provider can restrict the vendors from which the consumer can receive services or the consumer can pay a higher fee to use those vendors not associated with the manufacturer]; and

displaying to the user an order screen on said order terminal in response to reading the code stored on the portable digital storage device, the order screen including primary purchasing information provided by at least two of said plurality of business entities from which the user can order a product and/or service related to the image stored on the portable digital storage device, the primary purchasing information being modified in response to a rating of a predefined business relationship between said one of the plurality of storage device providers and said at least two of the plurality of business entities [column 5 «lines 11-19 and 28-44» | column 12 «line 6» : Reifel discloses that a user may elect, by activating links to print houses or vendors that are approved by the camera provider or decide to use a lower rated vendor and pay a fee].

While Reifel discloses at least two business entities, one of which has a higher rating than the other [column 5 «lines 28-44» : a business entity that is preferred by the manufacturer of the device has a "higher" rating than a business entity that is not preferred], Reifel does not expressly disclose modifying an order screen such that the higher rated business entity is displayed first. However, this feature was well known in the art at the time of Applicant's invention as taught by Mizumo.

Like Reifel, Mizumo is directed towards a network photo-print service. Mizumo discloses an order screen whereby a user may select from a plurality of business entities [Figure 10 «item P5»]. Mizumo discloses that the order in which the entities are displayed

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based on certain conditions for the delivery site [0120, 0124]. While Mizumo does not disclose displaying a higher rated business first, one of ordinary skill in the art would have applied Mizumo's ordering features to Reifel's teachings. As noted above, Reifel discloses two business entities that have different relationships to a camera provider. It would have been obvious for one of ordinary skill in the art, in reading Mizumo, to have organized the order screen such that the preferred business entity (the business in which the manufacturer has a relationship) is listed prior to the business entity with whom the manufacturer does not have relationship [column 5 «lines 41-45»]. One would have been motivated to provide such a modification to Reifel's photo service because displaying preferred businesses first increases the possibility that the customer will see the better prices for printing the photographs.

8> As to claims 24, 35 and 42, Reifel discloses:

reading a second portable digital storage device having a second image stored thereon coupled to the network connected order terminal by the user, the second portable digital storage device associated with a second one of the plurality of storage device providers [column 3 «lines 65-67» : camera providers];

displaying to the user an order screen on said order terminal including second purchasing information for ordering said same product and/or service but for the image stored on the second portable digital storage device, the second purchasing information including a higher price for said product and/or service in response to a lower rating of a predefined business relationship between said second one of the storage providers and one of

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the business entities [column 5 «lines 29-44» : the discounts for prints based on the providers relationship with the print house].

9> As to claims 25 and 37, Reifel discloses modifying the primary purchasing information to include a lower purchase price in response to better ratings of business relationships [column 5 «lines 28-44» | column 12 «line 6» : consumers receive cheaper prints at approved print houses or vendors].

10> As to claims 26 and 39, Reifel discloses said order terminal comprising one of the following, an automated teller machine, a kiosk, a personal computer, or a wireless device [Figure 13 «item 20»].

11> As to claims 27 and 41, Reifel discloses said portable digital storage device comprising one of the following: optical disc, magnetic floppy disk; flash memory device, or a digital camera [Figure 13 «items 5, 20»].

12> As to claims 29 and 40, Reifel discloses said one of a plurality of business entities provides one or more of the following: local printing of digital images, remote printing of digital images, on-line storage of digital images, providing digital storage media containing digital images, and providing associated goods and/or services with respect to hard copy prints [column 5 «lines 28-44»].

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13> As to claim 31, Reifel discloses a potential rating of said predefined business relationships include at least two levels [column 5 «lines 28-44» : restricted vs. non-restricted print houses].

14> As to claim 32, Reifel discloses the step of maintaining relationship data is performed by a service manager using a table in a database of the server [Figure 13 «item 13»].

15> As to claims 36 and 43, Reifel discloses excluding merchants based on ratings of the business relationships between the providers and the excluded merchants [column 1 «lines 61-66» : unauthorized print houses read on excluded merchants].

16> Claims 28 and 38 are rejected as being unpatentable over Reifel, in view of Vittal et al, U.S Patent No. 6,907,401 [“Vittal”].

17> As to claims 28 and 38, Reifel does not expressly disclose displaying different types of products and/or service on the order screen for the user to select, wherein some of the products and/or services are displayed more prominently based on said rating of a predefined business relationship between said one of the plurality of storage device providers and said one of a plurality of business entities.

However, Vittal discloses that such a feature was well known at the time of Applicant’s invention. Vittal specifically discloses modifying purchasing information based on relationships between the merchant and a service provider such that the merchant’s

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product is displayed (advertised) more prominently [column 1 «lines 55-64» where : being advertised more prominently implies that that they are “displayed first”].

It would have been obvious to one of ordinary skill in the art to modify Reifel to include Vittal’s teachings of prominently displaying provider products on a merchant’s site based on a contract between the merchant and the service provider. One would have been motivated to modify Reifel as such functionality improves upon Reifel’s merchant-service provider system by increasing the number of options in the merchant-provider contract.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dohm Chankong/
Examiner, Art Unit 2152